



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/432,414 05/01/95 RAY

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PETER C RICHARDSON
PFIZER INC
235 EAST 42ND STREET
NEW YORK NY 10017-5755

S
EXAMINER
MORRIS, F

ART UNIT PAPER NUMBER

3

1201

DATE MAILED:

08/01/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-6, 8 and 10-25 are pending in the application.
Of the above, claims 20-25 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-6, 8 and 10-19 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-6, 8, and 10-19, drawn to pyrimidines, classified in Class 544, subclass 335.

II. Claims 20-21, drawn to pharmaceutical compositions containing an additional active ingredient, classified in Class 514, subclass 256.

III. Claim 22, drawn to various intermediates, classified in Class 544, subclass 256.

IV. Claims 23-25, drawn to intermediates, classified in Class 544, subclass 334+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and III, IV are related as mutually exclusive species in intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (M.P.E.P. § 806.04(b), 3rd paragraph), and the species are patentably distinct (M.P.E.P. § 806.04(h)).

In the instant case, the intermediate product is deemed to be useful as corrosion inhibitors, photographic antifogging agents, sedatives, or as antihypertensives and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse

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on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

Inventions I and II are patentably distinct because the compositions of Group II requires an additional active ingredient for patentability. Also, the compositions of invention I can have separate utility as aromatase inhibitors as evidenced by EP 299,6894 of record in the parent application.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Zielinski on July 19, 1995 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-6, 8, and 10-19. Affirmation of this election must be made by applicant in responding to this Office action. Claims 20-25 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

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Claim 1-6, 8, and 10-19 are rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of Dickinson et al. (US 5,116,844) and Oida et al. (EP 332,387).

Dickinson et al. and Oida et al. generically embrace the instant compounds having the same fungicidal use. For example, note the structure of formula (I) of Dickinson et al. wherein Ar represents phenyl having one or two halogen and/or trifluoromethyl substituents, R¹ represents C₁-C₄ alkyl, R₂ is H or C₁-C₄ alkyl, and het represent pyrimidine substituted by halogen.

It is believed that one having ordinary skill in the art would have found the claimed compounds prima facie obvious, since they are generically embraced by the disclosed formula; In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). See also In re Malagari, 449 F.2d 1297, 182 USPQ 549 (CCPA 1974); In re Lemin, 332 F.2d 839, 141 USPQ 814 (CCPA 1964); In re Rosicky, 276 F.2d 656, 125 USPQ 341 (CCPA 1960). The requisite motivation for arriving at the claimed compounds stems from the fact that they fall within the generic class of compounds disclosed by Dickinson et al. and Oida et al. Accordingly, one having ordinary skill in the art would have been motivated to prepare any of the compounds embraced by the disclosed generic formula, including those encompassed by the claims, with the expectation that each of them would be suitable as fungicides.

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It is believed well settled that a reference may be relied upon for all that it would reasonably conveyed to one having ordinary skill in the art. In re Fracalossi, 681 F.2d 792, 215 USPQ 569 (CCPA 1982); In re Lamberti, 545 F.2d 747, 192 USPQ 278 (CCPA 1976); In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); In re Susi, supra.

Claims 10-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5,116,844. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant compounds and compositions are disclosed therein having fungicidal activity.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Claims 10-19 are directed to an invention not patentably distinct from claims 1-9 of commonly assigned 5,116,844.

As discussed supra, the instant compounds and compositions are disclosed therein. The claimed and art compounds share the same fungicidal activity.

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Commonly assigned US 5,116,844, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. § 103 if the commonly assigned case qualifies as prior art under 35 U.S.C. § 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 C.F.R. § 1.78(c) to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application. A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. § 103 based upon the commonly assigned case as a reference under 35 U.S.C. § 102(f) or (g).

Cuomo et al. (US 4,952,232) and Jautelat et al. (DE 3,813,841) are cited as showing the state-of-the-art.

No claim is allowed.

A facsimile center has been established in Group 1200, room 3C10. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or 305-3592.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Morris whose telephone number is (703) 308-4533.

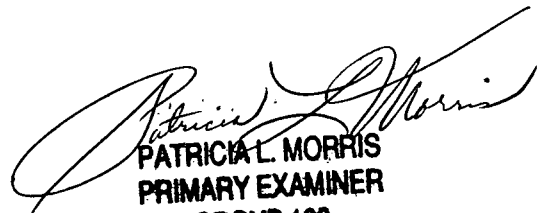
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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

MORRIS:jd
JULY 26, 1995


PATRICIA L. MORRIS
PRIMARY EXAMINER
GROUP 120